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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,213	08/27/2001	Shell S. Simpson	10008205-1	5700

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/941,213	Applicant(s) SIMPSON ET AL.	
	Examiner Stephan F Willett	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim(s) 15-17 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). The claims specify “module” and the specification states on page 21 the module can be implemented in software, thus the software must be stored on a “computer-readable medium needed to realize the computer program’s functionality”, MPEP 2105.

Claim Rejections - 35 USC § 103

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phang et al. with Patent Number 6,437,876 in view of Tonkin with Patent Number 6,616,702.
3. Regarding claim(s) 1, 8, 10, 15, 18, 21, 23, Phang teaches scaling print media based on paper size. Phang teaches using an user interface, col. 5, lines 50-52 to notify a user that a printer does not support a media type, col. 5, lines 64-65 or paper size, col. 7, lines 26-27 intended, col. 6, lines 3-10, col. 5, lines 19-20. Phang teaches scaling the media type so the print job can be printed, col. 6, lines 20-24. Phang teaches media sizes, col. 5, line 61. Phang teaches scaling factors/parameters, col. 6, lines 39-40. Phang teaches automatically scaling col. 7, lines 26-28 and notifying the user that an alternative scale was used, col. 6, lines 16-19, 53-55. Phang teaches a user interface with previously provided preferences as defaults, col. 2, lines 21-23. Phang teaches the invention in the above claim(s) except for explicitly teaching using network services, such as the Internet or a server. In that Phang operates to generate service requests via network, the artisan would have looked to the network arts for details of implementing printer.

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scaling. In that art, Tonkin, a related network device, teaches “content automatically will be scaled”, col. 7, line 45 in order to provide robustness. Tonkin specifically teaches a “WAN”, col. 4, line 1. Tonkin teaches scaling on the Internet, web services col. 4, lines 28-29, col. 13, lines 18-19. Further, Tonkin suggests that “a user to specify assembly instructions for a document”, col. 6, lines 33-34 will result from implementing document printing. The motivation to incorporate network capability insures applicability with current computers. Thus, it would have been obvious to one of ordinary skill in the art to incorporate the network as taught in Tonkin into the computer system described in the Phang patent because Phang operates peripherals and Tonkin suggests that optimization can be obtained within a network environment. Therefore, by the above rational, the above claim(s) are rejected.

1. Regarding claim(s) 2, 11, Phang teaches automatically scaling col. 7, lines 26-28 and notifying the user that a an alternative scale was used, col. 6, lines 16-19, 53-55.
2. Regarding claim(s) 3, 12, 19-20, Phang teaches a user interface to select a scaling factor, col. 8, lines 14-15.
3. Regarding claim(s) 4, 24-25, Phang teaches a user interface with previously provided preferences as defaults that are saved, col. 2, lines 21-23.
4. Regarding claim(s) 5, Phang teaches media sizes, col. 5, line 61.
5. Regarding claim(s) 6-7, 13-14, 17, 22, Phang teaches scaling at the printer or proxy type server, col. 8, lines 33-34, 45-47; col. 6, lines 39-30, 63-64 and Tonkin teaches scaling at servers, col. 15, lines 21-23, and reasons to combine are explained above.
6. Regarding claim(s) 9, 16, Tonkin teaches scaling on the Internet, web services, col. 4, lines 28-29, col. 13, lines 18-19, and reasons to combine are explained above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. A close review of the Horiuchi reference with Patent Number 5,956,466 and Cartier reference with Patent Number 6,111,654 are suggested. The other references cited teach numerous other ways to scale documents, thus a close review of them is suggested.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (571) 272-3890. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0044.
10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



Stephan Willett

Patent Examiner

February 10, 2005